

(3) transmitting said at least one control signal to said at least one origination transmitter before a specific time.

19. The method of claim 18, further comprising the step of embedding said at least one control signal in a signal containing said at least one instruct signal before transmitting at least a portion of said at least one instruct signal to said remote intermediate transmitter station.

20. The method of claim 18, wherein at least one of (i) said specific time is a scheduled time of transmitting said at least one instruct signal or some information associated with said at least one instruct signal from said remote intermediate transmitter station, and (ii) said at least one control signal is effective at said remote intermediate transmitter station to control at least one of said plurality of selective transfer devices at different times.

## **II. REMARKS**

### **A. Introduction**

The Office Action dated June 29, 1998 (Office Action) has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 2 and 13 are amended. Claims 2-20 are pending in the application.

Claims 2-8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 2, 4-12, and 18-20 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Campbell et al., U.S. Pat. No. 4,536,791.

Claims 13-16 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Campbell et al., U.S. Pat. No. 4,536,791, in view of Lambert, U.S. Pat. No. 4,381,522.

Claim 3 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Campbell, U.S. Pat. No. 4,536,791, in view of Nagel, U.S. Pat. No. 4,064,791.

Claim 17 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Campbell, U.S. Pat. No. 4,536,791, in view of Lambert, U.S. Pat No. 4,381,522, and further in view of Nagel, U.S. Pat. No. 4,536,791.

Claims 2-20 remain active in this application. No new matter is presented in the foregoing amendments. Approval and entry of same is respectfully requested.

**B. Response to Requirement Imposed Upon Applicants to Resolve Alleged Conflicts Between Applicants' Applications.**

Applicants note that the requirement of paragraph 8 of the Final Office Action mailed January 8, 1998, has been essentially reiterated in paragraph 4 of the recent Office Action. Applicants respectfully maintain the traversal of the requirements of paragraph 4 of the Office Action and reiterate below the reasons for traversal.

Paragraph 4 of the Office Action requires Applicants to either:

- (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; or
- (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or
- (3) resolve all conflicts between claims in the related 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications.

In addition, Examiner states that failure to comply with any one of these requirements will result in abandonment of the application.

Examiner states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. Examiner sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. Examiner has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 328 related co-pending applications and the present application. Further, Examiner states that an analysis of all claims in the 328 related

co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements in that Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to impose abandonment upon an application. The following remarks in Section (B) will explain Applicants' basis for this traversal.

**1. The PTO's New Requirement is an Unlawfully  
Promulgated Substantive Rule Outside the  
Commissioner's Statutory Grant of Power**

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6 (a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does NOT grant the Commissioner authority to issue substantive rules of patent law. Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 U.S.P.Q.2d 1677, 1686 (Fed Cir. 1991).<sup>1</sup> Applicants respectfully submit that the Examiner's creation of a new set of requirements based upon 37 CFR § 1.78(b) constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

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<sup>1</sup> Accord Hoechst Aktiengesellschaft v. Quigg, 917 F.2d 522, 526, 16 U.S.P.Q.2d 1549, 1552 (Fed Cir. 1990); Glaxo Operations UK Ltd. v. Quigg, 894 F.2d 392, 398-99, 13 U.S.P.Q.2d 1628, 1632-33 (Fed. Cir. 1990); Ethicon Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d 1152, 1154 (Fed. Cir 1988).

## **2. The PTO's Requirement is a Substantive Rule**

The first determination is whether the requirement as imposed by the PTO upon Applicants is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 U.S.P.Q.2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule's impact on the Applicant's rights and interests under the patent laws. *Fressola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules, the Commissioner receives no deference in his interpretation of the statutes and laws that give rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed Cir. 1996), citing, *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the effected party, the rule must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

### **a. The PTO Requirement is Substantive Because it Radically Changes Long Existing Patent Practice by Creating a New Requirement Upon Applicants Outside the Scope of 37 C.F.R. § 1.78 (b)**

The Examiner's requirement is totally distinguishable from the well articulated requirement authorized by 37 CFR § 1.78 (b), because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the

claims. Long existing patent practice recognizes only two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double patenting).<sup>2</sup> These two well established types of double patenting use an objective standard to determine when they are appropriate<sup>3</sup> and have a determinable result on the allowability of the pending claims.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 327 copending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued

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<sup>2</sup>MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

<sup>3</sup> The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

Therefore, the Examiner's new requirement departs from existing practice and therefore is a **substantive rule** beyond the authority of the PTO and is therefore, invalid.

**b. The New Requirement is Also a Substantive Rule  
Because it Adversely Impacts the Rights and  
Interests of Applicants to Benefits of the Patent**

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the applicant to claim his discovery. *Freesola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 U.S.P.Q. 145 (C.C.P.A. 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 U.S.P.Q. 143 (C.C.P.A. 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants ability to claim their invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny Applicants the full and complete PTO

examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications based on the PTO's incomplete examination on the merits would deny Applicants' the benefit of the full patent term of 17 years on each of Applicants' respective applications. Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

**c. Conclusion: Substantive Rule**

In summary, the requirement is a change to long existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Either finding means that the new requirement is a substantive rule. Since the Commissioner has no power to issue substantive rules, the requirement is an improperly promulgated substantive rule having no force of law.

**3. The PTO Requirement is Outside the Scope of 37 C.F.R. § 1.78 (b)**

Rule 78 (b) states that:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

The only **requirement** that Rule 78 (b) authorizes is the elimination of conflicting claims from all but one co-pending applications.

In the instant Office Action, Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 328 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 328 applications. None of the options in the requirement is authorize by Rule 78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within Rule 78 (b) regarding the rejection of conflicting claims, M.P.E.P § 822.01 states that:

Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of provisional double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

In light of the requirement of the Office Action, M.P.E.P § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with regard to the elimination of conflicting claims from all but one co-pending application.

**4. The Assertion That Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper**

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

- (1) for failure to respond within a provided time period (under Rule 135);
- (2) as an express abandonment (under Rule 138); or
- (3) the result of failing to timely pay the issue fee (under Rule 316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO. Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.



In the *Application of Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has asserted that there are conflicting claims in multiple applications, and that non-compliance of the Office Action's requirement will result in an automatic abandonment. Therefore, under *Mott's* analysis, the Office Action's result of abandonment of Applicant's application is legally untenable.

#### **5. Response to Apparent Conflict of Claims**

Applicants submit that the presentation of the Office Action Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Office Action Appendix compares representative claims of *other* applications in attempt to establish that "conflicting claims exist between the 328 related co-pending applications." Absent any evidence of conflicting claims between the Applicants' present application and any other of Applicants' co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

#### **6. Request for Withdrawal of Requirement**

Therefore, Applicants respectfully request that Examiner reconsider and withdraw the requirement that Applicants: (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the above identified 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications, which upon failing to do so will abandon the application.

## **7. Filing of Supplemental Oath**

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R. § 1.67 for each application when Examiner identifies allowable subject matter. Applicants respectfully propose that the filing of individual supplemental oaths attesting to the absence of claim conflicts between previously patented claims and subsequently allowed claims is a more reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants' right to appeal, etc. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

### **C. Response to Rejections under 35 U.S.C. § 112**

#### **1. Rejections Under 35 U.S.C. §112, Second Paragraph**

Claims 2-8 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. It is noted that the phrase "said at least two or more specific portions" in claim 2 lacked sufficient antecedent basis. Claim 2 has been amended to positively set forth "at least two or more specific portions."

#### **2. Conclusion**

Applicants respectfully submit that claims 2-8 particularly point out and claim the subject matter sufficiently for one of ordinary skill in the art to comprehend the bounds of the claimed invention. The test for definiteness of a claim is whether one skilled in the art would understand the bounds of the patent claim when read in light of the specification, and if the claims so read reasonably apprise those skilled in the art of the scope of the invention, no more is required.

*Credle v. Bond*, 25 F.3d 1556, 30 U.S.P.Q.2d 1911 (Fed. Cir. 1994). The legal standard for

definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 31 U.S.P.Q.2d 1754 (Fed. Cir. 1994). Applicants have amended the claims to enhance clarity and respectfully submit that all pending claims are fully enabled by the specification and distinctly indicate the metes and bounds of the claimed subject matter.

Applicants believe that the above recited changes are sufficient to overcome the rejections under 35 U.S.C. § 112, second paragraph, and respectfully request withdrawal of these rejections.

#### **D. Response to Obviousness Rejection of Claims**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim recitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). M.P.E.P. 706.02(j).

##### **1. 35 U.S.C. § 103 (a) Rejection over Campbell et al.**

Claims 2, 4-12, and 18-20 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Pat. No. 4,536,791 to Campbell et al. [hereinafter Campbell]. Applicants reassert that the rejection based upon Campbell is improper under 35 U.S.C. § 103 (a) as the Office Action has failed to establish that Campbell is available as reference under 35 U.S.C. § 102. All of the claims as herein presented are supported by Application Serial No. 317,510, filed November 3, 1981, and on which the instant application claims priority. The effective filing date for every pending claim is, thus, November 3, 1981. As Campbell issued after this effective filing date, Campbell is not available as a reference under 35 U.S.C. § 102(b).

Applicants submit that it has not been established that Campbell is a proper reference under 35 U.S.C. § 102(e). Under 35 U.S.C. § 102(e) an issued patent that was filed in the United States prior to the invention by Applicants of the claimed subject matter may be relied upon to show anticipation. Campbell issued from U.S. Application Serial No. 617,137 filed June 4, 1984, which is subsequent to the effective filing date of Applicants' claims. However, Campbell claims priority as a continuation of Ser. No. 348,937 filed November 27, 1981, which is a continuation-in-part (CIP) of Ser. No. 135,987 filed March 31, 1980. The earliest filing date of March 31, 1980, is relied upon in the Final Office Action. However, "In order to carry back the 35 U.S.C. § 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must . . . support the invention as required by 35 U.S.C. § 112, first paragraph." M.P.E.P. § 2136.03 (citing *In re Wertheim*, 646 F.2d 527, 209 U.S.P.Q. 554 (C.C.P.A. 1981)). There is no showing in the Office Action that the application filed March 31, 1980, supports the claims in Campbell (U.S. Pat. No. 4,536,791). Campbell, therefore, has not been established as a proper reference under 35 U.S.C. § 102(e) in the Office Action.

It has also been noted that Campbell has a PCT equivalent application that was published in October of 1981. The PCT publication has not been cited against Applicants' claims. Notwithstanding, the PCT publication is not prior art under 35 U.S.C. § 102(b) because it was not available more than one year prior to the effective filing date of Applicants' claims. The PCT application is also not prior art under 35 U.S.C. § 102(e) because it is not an application for patent filed in the United States.

Notwithstanding the availability of Campbell as prior art, Campbell fails to render Applicants' claims obvious as asserted in the Office Action. The following arguments demonstrate that Applicants' claims are not obvious in view of the invention disclosed in Campbell.

**a. Claim 2**

With respect to Applicants' claim 2, Campbell fails to show or suggest, *inter alia*, Applicants' claimed step of organizing two or more specific portions of multimedia

programming in accordance with said specific function to be performed with each said specific portion of multimedia programming, based on said step of controlling. In the recent Office Action, it is asserted that a special program is outputted to the subscriber of Campbell in response to entry of a keyword and activation of channel number 226. Campbell describes various control codes that enable or disable the descrambling of programming received at a converter at a user station. One such control word is event enable word 220, which includes channel number 226. Event enable word controls access at a particular time on a given channel during which a special event is transmitted. Campbell discloses outputting a special program or event *as transmitted*. Campbell includes no suggestion whatsoever of organizing two or more specific portions multimedia programming as presently claimed. Campbell fails to suggest any manipulation of two or more specific portion of multimedia programming. In the Office Action, it is asserted that Campbell suggests combining video and teletext for a single multimedia programming presentation. Applicants respectfully disagree. There is no suggestion that the Campbell system organizes video and teletext for a single multimedia programming presentation. In addition, there is clearly no suggestion in Campbell that any organizing be in accordance with any specific function to be performed or based on any step of controlling.

Accordingly, Campbell fails to show or suggest, *inter alia*, Applicants' claimed step of outputting said organized two or more specific portions of multimedia programming as a part of a single multimedia programming presentation to at least one of said output devices at said receiver station based on said step of organizing. As discussed above, Campbell fails to suggest two or more specific portions of multimedia programming organized as a part of a single multimedia programming presentation. Campbell, therefore, cannot show or suggest outputting said organized portion of multimedia programming based on said step of organizing.

Campbell also fails to show or suggest, *inter alia*, Applicants' claimed step of controlling said receiver station to receive at least two instruct signals in response to said subscriber command, wherein each one of said at least two instruct signals at least one of specifies and designates: (1) a specific portion of multimedia programming, and (2) a specific function to be

performed with said specific portion of multimedia programming. Campbell fails to show or suggest two instruct signals as presently set forth. In the recent Office Action, channel control word 200 and event enable word 220 of Campbell are relied upon to show two instruct signals. With respect to channel control word, it is asserted that a portion of a multimedia programming signal to receive is designated by tier code 202. Applicants respectfully disagree. Campbell describes, at column 13, lines 7-9, "Channel control word 200 includes a tier code 202 defining the level of access required for the program in question." There is no suggestion in Campbell that the tier code designates or specifies a specific portion of multimedia programming. To the contrary, the channel control word relates to the entire program with which it is transmitted and the tier code merely designates a level of access required for the program. It is noted that the entire program is always transmitted and received in the Campbell system. The tier code is used to enable the descrambling of the transmitted and received program. With respect to event enable word 220, it is asserted in the Office Action that address identifier 222, subscriber ID code 224, channel number 226, program enable code 228 are stored in converter control logic 104. However, the event enable word does not specify or designate the specific portion of multimedia programming to be stored. The event enable word also does not specify or designate that these codes are to be communicated to a memory location. Campbell describes, at column 14, lines 6-8, "the event enable word controls access at a particular time on a given channel during which a special event is transmitted." There is no suggestion in Campbell that event enable word designates a portion of a multimedia programming signal to communicate to a memory location as asserted in the recent Office Action. Campbell fails to show or suggest two instruct signals that specifies or designates (1) a specific portion of multimedia programming, and (2) a specific function to be performed with said specific portion of multimedia programming. Campbell, therefore, cannot show or suggest controlling said receiver station to receive at least two instruct signals as presently set forth. Campbell also fails to show or suggest that any controlling of said receiver station to receive at least two instruct signals is in response to said subscriber command.

Accordingly, Campbell fails to show or suggest, *inter alia*, Applicants' claimed step of detecting the presence of said at least two instruct signals at said receiver station. For the reasons discussed above, Campbell fails to show or suggest at least two instruct signals as presently set forth. Campbell, therefore, cannot show or suggest detecting the presence of said at least two instruct signals.

Furthermore, Campbell fails to show or suggest, *inter alia*, Applicants' claimed step of displaying at one of said output devices a television program that promotes a multimedia product or service. Campbell fails to show or suggest a television program that promotes a multimedia product or service. In the recent Office Action, it is acknowledged that Campbell fails to suggest a television program that promotes a multimedia product or service. However, it is asserted that it would have been obvious to promote special events on non-authorized channels and to air other commercials. Webster's New Collegiate Dictionary (1977) defines "multimedia" on page 756 as "using, involving, or encompassing several media." There is no suggestion that special event of Campbell includes several media or that other commercials would promote a *multimedia* product or service. Since Campbell fails to show or suggest a television program that promotes a multimedia product or service, Campbell cannot suggest displaying such a television program as presently claimed.

For at least the above reasons, Applicants respectfully submit that Campbell fails to show or suggest all of the claimed elements of Applicants' invention. Applicants accordingly request the withdrawal of this rejection of claim 2 under 35 U.S.C. § 103(a).

**b. Claim 9**

With respect to Applicants' claim 9, Campbell fails to show or suggest, *inter alia*, Applicants' claimed step of receiving at said subscriber station in accordance with said specific subscriber input, an instruct signal for processing and at least two specific portions of multimedia programming for outputting. In the Office Action, it is asserted that the entry of the key number in Campbell allows deliverance of a program to be outputted to the subscriber. Campbell fails to show or suggest an instruct signal that is received in accordance with said specific subscriber

input. It is suggested in the Office Action that the eligibility word 230 of Campbell shows an instruct signal. However, Campbell fails to suggest that eligibility word 230 is received in accordance with specific subscriber input. To the contrary, Campbell discloses, at col. 14, lines 22-27, "Eligibility word 230 is also transmitted from PCS 50 to converter 40 where it is stored in converter control logic 104. When the eligibility threshold code 238 is exceeded by the eligibility code of a given television program being sent to the converter, logic 104 will disable the converter until key number 236 is input." Thus, the eligibility word 230 must be received and stored prior to the entry of the key number by the subscriber. The eligibility word 230 is not received in accordance with said specific subscriber input as suggested in the recent Office Action. Campbell also fails to show or suggest at least two specific portions of multimedia programming that are received in accordance with said specific subscriber input. It is asserted in the recent Office Action that Campbell suggests combined video and teletext for a single multimedia programming presentation display. Applicants respectfully disagree. Campbell fails to suggest combined teletext and video in a single display. Campbell fails to show or suggest receiving two separate specific portions of multimedia programming. Campbell fails to teach this limitation since the subscriber reaction only causes a single television program to be received. There is no teaching in Campbell of at least two portions of programming being received in response to a single subscriber input.

Campbell also fails to show or suggest, *inter alia*, Applicants' claimed step of processing said instruct signal which organizes said at least two specific portions of multimedia programming, and outputs said at least two specific portions of multimedia programming as a part of a single multimedia programming presentation based on said step of determining. Campbell fails to show or suggest an instruct signal which organizes said at least two specific portions of multimedia programming. First, as discussed above, Campbell fails to suggest two specific portions of multimedia programming as presently set forth. Second, Campbell includes no suggestion whatsoever that the eligibility word 230 organizes any portions of multimedia programming. The eligibility word 230 of Campbell merely limits access to programs exceeding



an eligibility threshold. There is no suggestion that the eligibility word organizines anything at all. Eligibility word 230 of Campbell fails to show an instruct signal as presently set forth. Accordingly, Campbell fails to show or suggest processing said instruct signal as presently claimed.

Additionally, Campbell fails to show or suggest, *inter alia*, Applicants' claimed step of transferring from said subscriber station to said at least one remote data collection station at least one datum which, based on said step of processing, evidences one of processing said instruct signal and outputting said multimedia programming presentation. As discussed above, Campbell fails to show or suggest an instruct signal which organizes two portions of programming into a single multimedia presentation. Accordingly, Campbell cannot show or suggest a datum which evidences either processing said instruct signal or outputting said multimedia programming presentation. In the Office Action, it is suggested that the Campbell system monitors viewed programs for purposes which include billing and statistic gathering and thus shows transferring from a subscriber station to a remote data collection an indicia confirming delivery of the eligibility word 230. Applicants' respectfully disagree. Campbell fails to show or suggest monitoring viewed programs as asserted in the Office Action. Campbell fails to show or suggest any indicia confirming delivery of the eligibility word 230 as asserted in the Office Action. Campbell fails to show or suggest transferring any datum that is related to eligibility word 230 from converter 40 to head end station 11. Accordingly, Campbell fails to show or suggest a datum as presently set forth. Campbell, therefore, cannot show or suggest transferring from said subscriber station to said remote data collection station at least one such datum.

For at least the above reasons, Applicants respectfully submit that Campbell fails to show or suggest all of the claimed elements of Applicants' invention. Applicants accordingly request the withdrawal of this rejection of claim 9 under 35 U.S.C. § 103(a).

**c. Claim 18**

With respect to Applicants' claim 18, Campbell fails to show or suggest, *inter alia*, Applicants' claimed step of originating said at least one instruct signal at said at least one

origination transmitter station and delivering said at least one instruct signal to at least one origination transmitter, said at least one instruct signal being effective at said at least one receiver station to organize at least two specific portions of multimedia programming and to output said at least two specific portions of multimedia programming as a part of a single multimedia programming presentation at said receiver station, based on a subscriber input. Campbell fails to show or suggest an instruct signal being effective to organize at least two specific portions of multimedia programming. In the recent Office Action, the eligibility threshold code 238 of Campbell is relied upon to show an instruct signal. Campbell fails to suggest that the eligibility threshold code 238 is effective to organize at least two specific portions of multimedia programming. Campbell fails to show or suggest an instruct signal being effective to output said at least two specific portions of multimedia programming as part of a single multimedia programming presentation. Campbell fails to suggest that eligibility threshold code 238 is effective to output two specific portions of multimedia programming as part of a single multimedia programming presentation. Campbell therefore fails to show or suggest an instruct signal as presently set forth. Campbell, therefore, cannot show or suggest originating at least one such instruct signal at an origination transmitter station and cannot show delivering said at least one instruct signal.

Campbell also fails to show or suggest, *inter alia*, Applicants' claimed step of receiving said at least one control signal which at the remote intermediate transmitter station is operative to control the communication of said instruct signal. In the Office Action, it is asserted that control signals are inherently used to communicate the eligibility threshold code. Applicants do not agree that Campbell inherently shows reception of a control signal which is operative to control the communication of the eligibility threshold code. Campbell discloses that the eligibility word, which includes the eligibility threshold code, is transmitted from PCS 50 to converter 40 where it is stored in converter control logic 104. Campbell fails to show or suggest receiving any control signal which is operative to control the communication of the eligibility threshold code.

Additionally, Campbell fails to show or suggest, *inter alia*, Applicants' claimed step of transmitting said at least one control signal to said at least one origination transmitter before a specific time. As discussed above, Campbell fails to suggest a control signal as presently set forth. Campbell, therefore, cannot show or suggest transmitting at least one such control signal. Also, in the recent Office Action, it is acknowledged that Campbell fails to explicitly teach transmitting before a specific time. However, claim 18 does explicitly claim transmitting before a specific time. Campbell fails to show or suggest transmitting said control signal before a specific time as presently claimed.

For at least the above reasons, Applicants respectfully submit that Campbell fails to show or suggest all of the claimed elements of Applicants' invention. Applicants accordingly request the withdrawal of this rejection of claim 18 under 35 U.S.C. § 103(a).

**d. Dependent Claims 4-8, 10-12, 19 and 20**

Claims 4-8, 10-12, 19 and 20 each depend from one of independent claims 2, 9, or 18. As discussed *supra*, Campbell fails to show or suggest every element of any one of claims 2, 9, or 18 and thus, *ipso facto*, Campbell fails to show or suggest every element of dependent claims 4-8, 10-12, 19 and 20, and therefore, this rejection should be withdrawn and the claim be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

**2. 35 U.S.C. § 103 (a) Rejection over Campbell et al. in view of Lambert**

Claims 13-16 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Pat. No. 4,536,791 to Campbell et al. [hereinafter Campbell] in view of U.S. Pat. No. 4,381,522 to Lambert [hereinafter Lambert]. For the reasons set forth in section 1, Applicants assert that the rejection based upon Campbell is improper under 35 U.S.C. § 103 (a) as the Office Action has failed to establish that Campbell is available as reference under 35 U.S.C. § 102. Notwithstanding the availability of Campbell as prior art, Campbell fails to render Applicants'

claims obvious as asserted in the Office Action. The following arguments demonstrate that Applicants' claims are not obvious in view of Campbell in view of Lambert.

**a. Claim 13**

With respect to Applicants' claim 13, Campbell in view of Lambert fails to show or suggest, *inter alia*, Applicants' claimed step of receiving at least one instruct signal at said remote intermediate mass medium transmitter station, wherein said at least one instruct signal is operative at the remote receiver station to organize at least two specific portions of said multimedia programming and to output said at least two specific portions of said multimedia programming as a part of a single multimedia programming presentation at said receiver station, based on a subscriber reaction to information contained in said mass medium programming, and communicating said at least one instruct signal to said transmitter. Campbell in view of Lambert fails to show or suggest an instruct signal operative at the remote receiver station to organize at least two specific portions of multimedia programming. In the recent Office Action, it is asserted that the eligibility code 206 or channel control word 200 operates to coordinate which programs will be viewed. Campbell discloses, at column 13, lines 1-7, that the channel control word 200, which includes eligibility code 206, identifies a program to the converter. The channel control word merely defines the codes required to access the program being transmitted. Campbell fails to suggest that the channel control word is operative to organize anything at all. Programs are transmitted in a complete form over the Campbell system. The control codes disclosed by Campbell merely enable the user station to process and descramble television signals of complete television programs. There is no suggestion in Campbell that any control code is operative to organize specific portions of multimedia programming. Campbell fails to suggest that any specific portions of multimedia programming are organized at the converter. Campbell, therefore, fails to show or suggest an instruct signal as presently set forth.

Campbell in view of Lambert fail to show or suggest an instruct signal operative to output two specific portions of multimedia programming as a part of a single multimedia programming presentation. As noted above, the channel control word of Campbell is relied upon to show an

instruct signal. The channel control word merely defines the codes required to access the program being transmitted. Campbell includes no suggestion the channel control word affects the output of anything other than the program being transmitted. Campbell fails to teach that the channel control word is operative to output two specific portions of multimedia programming as part of a single multimedia presentation.

Campbell in view of Lambert also fails to show or suggest receiving at least one instruct signal operative to organize and to output based on a subscriber reaction to information contained in said mass medium programming. In the recent Office Action, it suggested that the eligibility threshold code 238 is a subscriber reaction. Applicants respectfully disagree. Campbell fails to suggest that the eligibility threshold code 238 is a subscriber reaction to information contained in said mass medium programming. There is no suggestion in Campbell that a subscriber enters a eligibility threshold in reaction to information in mass medium programming.

For at these reasons, Campbell in view of Lambert fails to show or suggest an instruct signal as presently set forth. Accordingly, Campbell in view of Lambert fails to show or suggest receiving at least one such instruct signal as presently claimed.

Additionally, Campbell in view of Lambert fails to show or suggest, *inter alia*, Applicants' claimed step of receiving at least one control signal at said remote transmitter station wherein said at least one control signal controls the communication of said mass medium programming and said at least one instruct signal between said remote transmitter station and said remote receiver station. In the recent Office Action, it is acknowledged that Campbell fails to show or suggest control signals as presently set forth. However, it asserted that Lambert suggests a two-way cable system for transmitting programs at a user's request wherein control words thus control the communication. Applicants respectfully disagree. Lambert shows a cable television system that responds to signals from viewers to see particular programs. In Lambert a microprocessor 11 responds to viewer selection signals provided on telephone line 12 to provide a schedule video signal. Microprocessor 11 also provides selecting control signals to the different program sources 25 and 26 to enable them to broadcast in accordance with the schedule

carried by the schedule video signal. Lambert fails to suggest receiving any control signal that controls the communication of mass medium programming and an instruct signal as presently claimed. There is, therefore, no suggestion to modify the Campbell system to receive a control signal as presently set forth.

Furthermore, Campbell in view of Lambert fails to show or suggest, *inter alia*, Applicants' claimed step of transmitting from said remote transmitter station at least one information transmission containing said mass medium programming and said at least one instruct signal. As discussed above, Campbell in view of Lambert fails to show or suggest an instruct signal as presently set forth. Accordingly, Campbell in view of Lambert fail to show or suggest an information transmission containing said mass medium programming and said at least one instruct singal. Campbell in view of Lambert, therefore, cannot show or suggest transmitting at least one such information transmission.

For at least the above reasons, Applicants respectfully submit that Campbell in view of Lambert fails to show or suggest all of the claimed elements of Applicants' invention. Applicants accordingly request the withdrawal of this rejection of claim 13 under 35 U.S.C. § 103(a).

**b. Dependent Claims 14-16**

Claims 14-16 depend from independent claim 13. As discussed *supra*, Campbell fails to show or suggest every element of claim 13 and thus, *ipso facto*, Campbell fails to show or suggest every element of dependent claims 14-16, and therefore, this rejection should be withdrawn and the claim be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

**3. 35 U.S.C. § 103 (a) Rejection over Campbell et al. in view of Nagel**

Claim 3 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Pat. No. 4,536,791 to Campbell et al. [hereinafter Campbell] in view of U.S. Pat. No. 4,064,490 to

Nagel [hereinafter Nagel]. For the reasons set forth in section 1, Applicants assert that the rejection based upon Campbell is improper under 35 U.S.C. § 103 (a) as the Office Action has failed to establish that Campbell is available as reference under 35 U.S.C. § 102.

Notwithstanding the availability of Campbell as prior art, Campbell in view of Nagel fails to render Applicants' claims obvious as asserted in the Office Action.

Claim 3 is dependent upon, and thus includes every limitation of independent claim 2. As discussed above, the primary reference to Campbell fails to suggest the steps of controlling said receiver station to receive at least two instruct signals in response to said subscriber command, wherein each one of said at least two instruct signals at least one of specifies and designates: (1) a specific portion of multimedia programming, and (2) a specific function to be performed with said specific portion of multimedia programming: detecting the presence of said at least two instruct signals at said receiver station; organizing two or more specific portions of multimedia programming in accordance with said specific function to be performed with each said specific portion of multimedia programming, based on said step of controlling; and outputting said organized two or more specific portions of multimedia programming as a part of a single multimedia programming presentation to at least one of said output devices at said receiver station based on said step of organizing as set forth in independent claim 2. There is no suggestion that the secondary reference to Nagel corrects this deficiency of the primary reference to Campbell. For at least this reason, Applicants respectfully submit that Campbell in view of Nagel fails to render claim 3 obvious and accordingly request the withdrawal of this rejection of claim 3.

**4. 35 U.S.C. § 103 (a) Rejection over Campbell et al. in view of Lambert and further in view of Nagel**

Claim 17 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Pat. No. 4,536,791 to Campbell et al. [hereinafter Campbell] in view of U.S. Pat. No. 4,381,522 to Lambert [hereinafter Lambert] as applied to claim 13 above, and further in view of U.S. Pat. No. 4,064,490 to Nagel [hereinafter Nagel]. For the reasons set forth in section 1, Applicants assert

that the rejection based upon Campbell is improper under 35 U.S.C. § 103 (a) as the Office Action has failed to establish that Campbell is available as reference under 35 U.S.C. § 102. Notwithstanding the availability of Campbell as prior art, Campbell in view of Lambert and further in view of Nagel fails to render Applicants' claims obvious as asserted in the Office Action.

Claim 17 is dependent upon, and thus includes every limitation of independent claim 13. As discussed above, the Campbell in view of Lambert fails to suggest the steps of receiving at least one instruct signal at said remote intermediate mass medium transmitter station, wherein said at least one instruct signal is operative at the remote receiver station to organize at least two specific portions of said multimedia programming and to output said at least two specific portions of said multimedia programming as a part of a single multimedia programming presentation at said receiver station, based on a subscriber reaction to information contained in said mass medium programming, and communicating said at least one instruct signal to said transmitter; receiving at least one control signal at said remote transmitter station wherein said at least one control signal controls the communication of said mass medium programming and said at least one instruct signal between said remote transmitter station and said remote receiver station; and transmitting from said remote transmitter station at least one information transmission containing said mass medium programming and said at least one instruct signal as set forth in independent claim 13. There is no suggestion that Nagel corrects this deficiency of the combination of Campbell and Lambert. For at least this reason, Applicants' respectfully submit that Campbell in view of Lambert and further in view of Nagel fails to render claim 17 obvious and accordingly request the withdrawal of this rejection of claim 17.



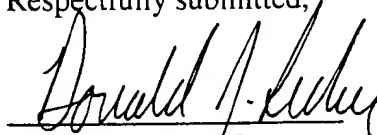
### III. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such informalities.

Date: December 29, 1998  
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Respectfully submitted,



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